

Remarks

Claims 1-14 are pending. Claims 1-14 are rejected by the Examiner. Claims 1, 4, 9, 11 and 12 are amended. Applicant respectfully asserts that no new matter is added by way of the present amendments. Further, Applicant herewith cancels claims 2, 5, 7-10 and 13-14 in an effort to assist in overcoming the rejections and to provide for allowance of the pending claims.

On page 2 of the Office Action, claims 1-14 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses the rejection. Applicant submits amended claims to assist in overcoming the rejection and requests the Examiner reconsider the rejected claims in light of the amendments.

On page 2 of the Office Action, claims 1-6 and 11-12 are rejected under 35 U.S.C. §103(a) over Dickson (U.S. Pat. 4,984,529) in view of Woods (U.S. Pat. 4,757,901), Chua (U.S. Pat. Appl. 2002/0134299), and Covell (U.S. Pat. 292,412). Applicant respectfully traverses the rejection.

On page 4 of the Office Action, claims 7-8, 13 are rejected under 35 U.S.C. §103(a) over Chua ('299) in view of Woods ('901) and Sweet (U.S. Pat. 5,358,279). Applicant respectfully traverses the rejection.

On page 5 of the Office Action, claims 9-10 and 14 are rejected under 35 U.S.C. §103(a) over Chua ('299) in view of Dickson ('529), Woods ('901), and Sweet ('279). Applicant respectfully traverses the rejection.

Three criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference, or combination of references, must teach or suggest all the claim limitations. MPEP § 2142. Applicants respectfully traverse the rejection since the prior art fails to disclose all the claim limitations and there would be no motivation to combine the references as proposed by the Examiner.

At the outset, there is no motivation to combine these references with regard to the present invention. Applicant discloses and claims an apparatus for assisting in highlighting or annotating documents without actually doing so on the document of interest. The inventive apparatus is laid upon the document of interest and then annotated and/or highlighted. The invention is not directed toward a bookmark as is Dickson ('529), Chua ('299), Sweet ('279), and Covell ('412). Covell ('412) is not listed as prior art for either Sweet ('279) or Dickson ('429), nor is Dickson ('529) referenced by Sweet ('279). There simply is no motivation within these documents to combine them, nor would one skilled in the art attempting to solve the problem addressed by the present invention seek to locate such references. Applicant respectfully requests that the rejections based on Dickson ('529), Chua ('299), Sweet ('279) and Covell ('412) be withdrawn and that Examiner reexamine the affected claims.

Turning now to the rejections of claims 1-6 and 11-12, as the Examiner recognizes, Dickson discloses an educational bookmark. Dickson discloses an apparatus consisting of a sheet having a first side, a second side, a top edge on the first

side and a top edge on the second side. Dickson further provides for a writing instrument (20) and indicates that the sheet assembly 12 is manufactured from a variety of materials, and is erasable and therefore, reusable. The reusability arises from the use of a clear vinyl overlamine. (Col. 3, 16-30.)

In contrast, the present invention discloses and claims a reusable transparent sheet, without requiring an overlamine, manufactured from vinyl or non-top coated polyester film.

However, contrary to the Examiner's observations, Dickson does not disclose a clamping device that is adhered, or removably adhered, to the erasable sheet as in the present invention. The Dickson device is a retaining clip 26, simply used to retain the writing instrument 20 either slidably or in a snap-on configuration.

The Examiner cites the bookmark device in Chua for the proposition that it is known to manufacture erasable bookmarks from a transparent material (including polyester). Chua discloses polyester for the purpose of statically adhering the bookmarker to the page of interest. Chua does not, as Applicant discloses and claims, disclose non-top coated polyester for ease of marking and erasing.

The Examiner next cites Woods for the disclosure of non-top coated material as an erasable surface which may be packaged with a dry-erase marker and eraser. However, the Woods disclosure does not provide for transparent non-top coated material and, in fact, teaches away from such utility. The Woods device provides a label for video cassettes and computer disks. A transparent label would make it quite difficult to read the markings because the label will overlay existing markings, labels,

etc., on the cassette or disk. As a result, Woods does not teach or suggest transparency to one skilled in the art.

Covell is cited for the proposition that it teaches a clamping structure. The Covell disclosure is simply that: a clamp. As discussed above, Dickson fails to disclose an apparatus that is removably adhered both to the transparent sheet as well as to the document of interest. Covell also fails to teach such structure. Covell simply allows the user to clamp something and neither teaches nor suggests the adherence of one arm of the clamp to a transparent sheet. The inventive disclosure provides for the clamp to be removably adhered to the top edge of the first side (the side to be highlighted or marked) of the transparent sheet. Neither Dickson nor Covell, nor the combination thereof, disclose this feature.

For at least these reasons, Applicants submit that Dickson fails to disclose every limitation in claims 1, 3, 4, 6 and 11-12 as amended. Moreover, Chua, Woods, and Covell fail to remedy Dickson's deficiency in this respect. In light of the foregoing, Applicants respectfully request reconsideration of claims 1, 3, 4, 6 and 11-12 as amended.

With regard to the rejections of claims 7-8 and 13 over Chua in view of Woods and Sweet, Applicant herewith cancels these claims.

Turning to the rejection of claims 9-10 and 14 under 35 U.S.C. §103(a) as unpatentable over Chua ('299) in view of Dickson ('529), Woods ('901), and Sweet ('279), Applicant herewith cancels these claims.

In view of the amendments and reasons provided above, it is believed that all pending claims are in condition for allowance. Applicants respectfully request favorable reconsideration and early allowance of all pending claims.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicants' attorney of record, Jeffrey R. Stone at (952) 253-4130.

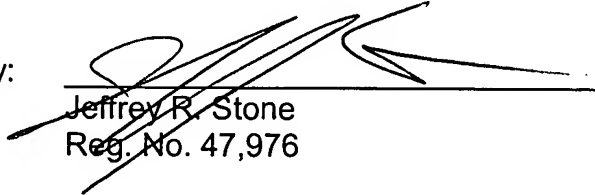
Respectfully submitted,

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9/7/04

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